

REMARKS

In the Office Action¹ the Examiner rejected:

- (1) claims 1-32 under 35 U.S.C. 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- (2) Claims 1-20 are rejected under 35 U.S.C. 101 as allegedly being directed to nonstatutory subject matter;
- (3) Claims 1-8, 10-11, 13-18, 20-21 and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al., B2B Collaborative Commerce with Sametime, QuickPlace and WebSphere Commerce Suite, IBM International Technical Support Organization, International Business Machine Corporation; August 2001; 274 pages; ibm.com/redbooks ("*Nielsen*") in view of Jean-Jacques Dubray, OAGIS Implementation Using the ebXML CPP, CPA and BPSS specifications v1.0, 10/4/2001 ("*Dubray*"); and
- (4) Claims 9, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nielsen* in view of *Dubray*, further in view of www.ebxml.org, News and Articles, ebXML - Enabling A Global Electronic Market, United Nations and OASIS Join Forces to Produce Global XML Framework for Electronic Business, Boston, MA, USA & Geneva, Switzerland, September 15, 1999, "*ebXML*").

By the present amendment Applicant amends claims 1-21 and 25. Support for the amendments can be found in the claims as originally filed. Claims 1-32 remain pending.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 21 and 25 have been amended, in part, to address the rejection under 35 U.S.C. § 112. Applicant respectfully requests the Examiner withdraw the rejection of

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

claims 1-32 under 35 U.S.C. § 112. Should any further amendment to the claims be considered necessary, the Examiner is invited to contact the Applicant's undersigned representative.

Rejections Under 35 U.S.C. § 101

Claims 1-20 have been amended to address the rejection under 35 U.S.C. § 101. Applicant respectfully requests the Examiner withdraw the rejection of claims 1-20 under 35 U.S.C. § 101. Should any further amendment to the claims be considered necessary, the Examiner is invited to contact the Applicant's undersigned representative.

Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of: claims 1-8, 10-11, 13-18, 20-21 and 23-32 under 35 U.S.C. § 103(a) as being unpatentable over *Nielsen* in view of *Dubray*. A *prima facie* case of obviousness has not been established with respect to any of these claims.

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P.* § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The

factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been established for at least the reasons that the scope and content of the prior art have not been properly determined nor have the differences between the claimed invention and the prior art been properly ascertained.

With respect to independent claim 1, on page 9 of the Office Action the Examiner correctly concedes that *Nielsen* does not teach or suggest:

predefining a sequence of business transactions to be executed in a first computer according to received sequence modification input received prior to the predefining; (emphasis added)

The Office Action relies on *Dubray* to cure these deficiencies of *Nielsen*. This reliance on *Dubray*, however, is in error, at least with respect to the claims as amended.

Dubray discloses “OAGIS Implementation Using the ebXML CPP, CPA and BPSS specifications v1.0” (title). On page 5 of the Office Action, the Examiner characterizes *Dubray* as follows:

Figure 8 shows a predefined sequence (process purchase order business transaction), depending on the input (sequence modification input) one of the possible three paths will be taken (modification of the sequence). (emphasis added)

Even if the “Process Purchase Order Transaction” of *Dubray* shown in Fig. 8 could constitute a “predefined sequence,” which Applicant does not concede, there is no disclosure or suggestion that the sequences represented by the “Process Purchase

Order Transaction” are “predefined [...]according to received sequence modification input received prior to the predefining,” as claimed. Rather, as the Examiner explains on page 5 of the Office Action, the “predefined” “Process Purchase Order Transaction” is “modif[i]ed” via the use of “condition expressions” (Dubray, page 20) and a “sequence modification input” (emphasis added). Since the “Process Purchase Order Transaction” is “modif[i]ed” by the receipt of the “sequence modification input,” the “sequence modification input” is received after any “predefining” (emphasis added).

Therefore, *Dubray* fails to disclose or suggest at least:

predefining a sequence of business transactions to be executed in a first computer according to received sequence modification input received prior to the predefining; (emphasis added)

as recited in claim 1.

Accordingly, a prima facie case of obviousness has not been established for claim 1 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claims 21, 23 and 25, although of different scope, contain similar features to those of claim 1. Therefore, the rejections of these claims under 35 U.S.C. § 103(a) is not supported by the art of record, for at least reasons similar to those set forth above with respect to claim 1. Moreover, dependent claims 2-8, 10-18, and 20 are allowable at least for their dependence from allowable independent claim 1 for the reasons given above with respect to claim 1, dependent claim 24 is allowable at least for its dependence from allowable independent claim 23 for the reasons given above with respect to claim 23, and dependent claims 26-32 are allowable for at least their

dependence from allowable independent claim 25 for the reasons given above with respect to claim 25. Accordingly, the Examiner should withdraw each of the 35 U.S.C. § 103(a) rejections of claims 1-8, 10-11, 13-18, 20-21 and 23-32.

Applicant respectfully traverses the rejection of dependent claims 9, 19 and 22 under 35 U.S.C. 103(a) as being unpatentable over *Nielsen* in view of *Dubray*, further in view of *ebXML*, insofar as it applies to the claims as amended.

Claims 9 and 19 depend from claim 1 and thus include all the elements thereof. Claim 22 depends from claim 21 and thus include all the elements thereof. As set forth above, neither of *Nielsen* nor *Dubray* teach or suggest at least:

predefining a sequence of business transactions to be executed in a first computer according to received sequence modification input received prior to the predefining; (emphasis added)

as recited in independent claims 1 and 21 and included in claims 9, 19 and 22.

The Office asserted that *ebXML* teaches “wherein the communication module is adapted to communicate via a protocol selected from the group of: ebXML messaging, SOAP, and WSDL,” “wherein the communication format comprises XML-based UBL” and “wherein communicating is supported by a communication module on the first computer and wherein the communication module communicates using a communication format wherein the communication format comprises XML-based UBL.” Even if these assertions were correct, which Applicant does not concede, *ebXML* still fails to teach or suggest the above-quoted elements recited in claim 1 and thus included in claim 9 and 19, and recited in claim 21 and thus included in claim 22. Thus, *ebXML* does not compensate for the deficiencies of *Nielsen* and *Dubray*.

Therefore, the Office has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Office Action has provided insufficient motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no prima facie case of obviousness has been established. The rejection of dependent claims 9, 19 and 22 under 35 U.S.C. § 103(a) over *Nielsen* in view of *Dubray*, further in view of *ebXML*, insofar as it applies to the claims as amended, is thus improper and should be withdrawn.

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-32 in condition for allowance. Applicant submits that the proposed amendments to claims 1-21 and 25 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment

would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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